



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/759,445

01/14/2004

Eric R. Soldan

MS1-1790US

7839

22801

7590

10/06/2006

LEE & HAYES PLLC

421 W RIVERSIDE AVENUE SUITE 500
SPOKANE, WA 99201

EXAMINER

QUELER, ADAM M

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/759,445	Applicant(s) SOLDAN ET AL.	
	Examiner Adam M. Queler	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 17-21 and 26-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Application filed January 14, 2004, Election filed 07/12/2006.
2. Claims 1-40 are pending in the case. Claims 1-16 and 22-25 are elected. Claims 1, 10, and 22 are elected independent claims.
3. Claims 17-21 and 26-40 have not been cancelled as Applicant's instructions to cancel the claims does not constitute of valid amendment under 37 CFR 1.121(c) which states "Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application."

Election/Restrictions

4. Applicant's election without traverse of Group I in the reply filed on 07/12/2006 is acknowledged.
5. Claims 17-21 and 26-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/12/2006.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
7. **Claims 9-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Art Unit: 2178

8. The USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101.

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claim(s) 9-16 define a computer readable medium with descriptive material. A computer readable medium as defined by the specification as including a “modulated data signal, “carrier wave,” or substantially anything. While “functional descriptive material” may be claimed as a statutory product (i.e., a “manufacture”) when embodied on a tangible computer readable medium, a signal or carrier wave embodying that same functional descriptive material is neither a process nor a product (i.e., a tangible “thing”) and therefore does not fall within one of the four statutory classes of § 101. Rather, a “signal” is a form of energy, in the absence of any physical structure or tangible material.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. **Claims 10-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 10 describes emulation results of an application and creating bitmaps. There is no disclosure of these activities nor does the specification even appear to use these terms at all. Although, the claims are as originally filed the complete lack of a nexus with the specification would not convey to one skilled in the relevant art that Applicant had invented the claimed subject matter.

11. Claims 1-16, and 22-25 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

All of the claims generally recite translating video content into a binary format. No details of this conversion are given in the specification. No details are given as to what the binary format actually entails. Therefore one of ordinary skill in the art would have to resort to undue experimentation to first invent a binary format suitable for encoding the disclosed video content, and then invent a process for translating into the format.

Claims 4 and 12 appear to recite translating different formats into a document object models. As these are not normal formats, and there is no disclosure of the binary format or the bitmap format (as noted above), similar undue experimentation would have to be undertaken to achieve this conversion.

Art Unit: 2178

As described above claim 10 describes emulation results of an application and creating bitmaps that have no corresponding disclosure, and similarly raise the issue of whether or not a skilled artisan would be able to make or use the claimed subject matter.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 10-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As described above that lack of antecedent basis in the specification of the majority of the language in the claim, creates ambiguity as to the proper meaning of the claims. It appears that Applicant is trying to claim similar subject matter as independent claim 1, the claims will be viewed in that light for examining purposes only.

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-5, 7-13, 15, 16 and 22-25 rejected under 35 U.S.C. 102(e) as being anticipated by Blair et al. (US 20040133855A1).

Regarding dependent claim(s) 1, 9, Blair discloses compiling formatted video content (para. 15, information stream, data files) into a binary format (para. 7, binary code) that includes layout aspects of the formatted video content (para. 28).

Regarding independent claim(s) 10, as described above, the scope of claim 10 is unclear however, it appears the Applicant is trying to claim similar subject matter as claim 1 and the claims are rejected under the same rationale. Additionally Blair teaches that the invention is for optimized layout of the original web page. Therefore, inherently, in the normal course of operation Blair will present all the original features of the original web page such as layout, rendering, UI interaction, and dynamic aspects.

Regarding independent claim(s) 22, Blair discloses compiling formatted video content (para. 15, information stream, data files) into a binary format (para. 7, binary code) that includes layout aspects of the formatted video content (para. 28). Blair discloses storage for the content (para. 23) and the server does the compilation (para. 22). Blair teaches that the invention is for optimized layout of the original web page. Therefore, inherently, in the normal course of operation Blair will present all the original features of the original web page such as layout, rendering, UI interaction, and dynamic aspects.

Regarding dependent claim(s) 2, 11, 23, Blair discloses the formatted video content includes a markup language (para. 7). Blair teaches the format is specific to XML (para. 16). Blair teaches the process is specific to a predetermined client (para. 20). Blair teaches the process renders the video content in the binary format so as to be consistent with the original markup language (para. 36).

Art Unit: 2178

Regarding dependent claim(s) 3, Blair teaches the formatted video content includes source content in one or more language (para. 7). Blair teaches an email format (para. 15).

Regarding dependent claim(s) 4, 12, Blair teaches translating the content in the binary format with DOM into a DOM hierarchy corresponding to the original content (para. 36).

Regarding dependent claim(s) 5, 13, Blair teaches that the invention is for optimized layout of the original web page. Therefore, inherently, in the normal course of operation Blair will present all the original features of the original web page such as layout, rendering, UI interaction, dynamic aspects, form elements, scrolling, navigation and event handling.

Regarding dependent claim(s) 7, 15, 25, Blair teaches XHTML with CSS (para. 32).

Regarding dependent claim(s) 8, 16, in the normal course of operation Blair would inherently come across web sites that contained translated words. As described in claim 1 above Blair would convert content along with those words in to the binary format.

Regarding dependent claim(s) 24, Blair teaches cable (para. 5).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

Art Unit: 2178

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blair.

Regarding dependent claim(s) 6, 14, Official Notice is taken that, in the normal course of operation Blair would encounter web pages that have an inline image and shape in which they are to be placed. Blair does not specifically recite reflowing such elements consistent with a display resolution and size, however it would have been obvious to one of ordinary skill in the art at the time of the invention to do so as an object of Blair was to adapt the style to the specific display (para. 38), and used reflow to accomplish this goal (para. 55).

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140.


The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

aq


STEPHEN HONG
SUPERVISORY PATENT EXAMINER